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DOCKET NO.: I00168.70061.US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: John W. Arba et al.
Serial No: 09/954,986
Confirmation. No.: 7682
Filed: September 18, 2001
For: ELECTRODEIONIZATION DEVICE AND METHODS OF USE

Examiner: Betsey Morrison Hoey
Art Unit: 1724

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

The undersigned hereby certifies that this document is being placed in the United States mail with first-class postage attached, addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the 6 day of August, 2003.


Maureen Joyce

Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

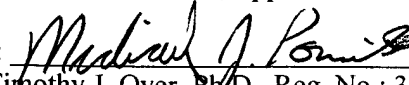
Transmitted herewith are the following documents:

- ☒ Response to Office Action
- ☒ Return Receipt Postcard

If the enclosed papers are considered incomplete, the Mail Room and/or the Application Branch is respectfully requested to contact the undersigned at (617) 720-3500, Boston, Massachusetts.

A check is not enclosed. If a fee is required, the Commissioner is hereby authorized to charge Deposit Account No. 50/0214. . A duplicate of this sheet is enclosed.

Respectfully submitted,
John W. Arba et al., Applicants

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Date: August 6, 2003
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RESPONSE TO ELECTION/RESTRICTION REQUIREMENT

Dear Sir:

In response to the Election/Restriction Requirement dated May 6, 2003, the Applicants elect Group I, claims 1-5, 11-19, 42-44, with traverse.

Applicants' traversal is based on two grounds.

First, the Applicants note that the only basis provided by the Patent Office for restriction of the Group I versus Group II claims is that the inventions described are unrelated, i.e. independent (paragraph 2 of the Election/Restriction Requirement). Applicants respectfully disagree that all of the claims of Group II, as identified in the Election Restriction Requirement, are unrelated to (i.e. independent from) all of the Group I claims, as asserted by the Patent Office. Specifically, Applicants respectfully disagree that claims 23-25, which are currently included in the Group II claims, are unrelated to the invention defined by certain of the Group I claims. Rather, as discussed below, these claims are not unrelated to or independent from certain of the Group I claims.

As set forth in MPEP §808.01 (cited in the Election/Restriction Requirement), inventions are independent, i.e. unrelated, if it can be shown that: (1) they are not disclosed as capable of

use together and (2) they have different modes of operation, different functions, or different effects (see MPEP form paragraph 8.20.02 – emphasis added). In paragraph 2, the Election/Restriction Requirement states, with respect to Group I and Group II claims, that the inventions are unrelated because they have different functions – Group I claims having the function of treating an electrodeionization device, and Group II claims having the function of treating water. However, since the Patent Office nowhere suggests that the Applicants' specification does not disclose that the Group I and Group II inventions are capable of use together, the Patent Office has failed to establish the first criteria stated above for showing that the inventions are independent – namely that they are not disclosed as capable of use together. Moreover, with respect to invention recited in claims 23-25, the statement that the function of this invention is “different” from the function of all of the Group I claims is not accurate.

Specifically, independent claim 23 defines a method comprising a combination of: (1) treating water by passing it through an electrodeionization device; and (2) passing water at a certain, elevated, temperature for a predetermined period of time through the electrodeionization device to treat the device. By comparison, certain of the Group I claims (e.g. independent claim 1 and claim 3, dependent therefrom) are directed to a method including a step, similar to step (2) above, of treating an electrodeionization device by passing water through the device at an elevated temperature and maintaining the elevated temperature for a predetermined period of time. In view of this relationship, the invention defined by claims 23-25 is fully capable of use together with the invention described by at least some of the Group I claims. In essence, while the invention described in claims 23-25 may perform some additional functions beyond the Group I claimed invention, it also performs functions in common with at least of the some subject matter of the Group I claims (i.e. the function of passing elevated temperature water through the device to treat the device).

Moreover, further supporting the contention that inventions described in certain of the Group I and Group II claims are capable of use together, in Applicants' specification, methods are described that include both steps for purifying water by passing it through an electrodeionization device and for treatment of the electrodeionization device utilizing water having a temperature high enough to effect sanitation (see, e.g., page 2, lines 16-19; page 10, lines 10-32; and page 11, line 11 – page 12, Tables 2 and 3). Thus, Applicants' specification

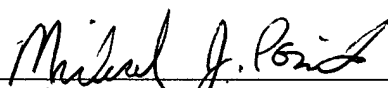
makes clear that the methods described in at least claims 23-25 of Group II are fully capable of being performed together with the methods described at least some of the Group I claims, such as claims 1-5. In fact, as discussed above, independent claim 23 specifically recites an example of such a combined method.

Since, as shown above, the invention described in at least claims 23-25 of the Group II claims is not unrelated to the Group I invention, as relied on by the Patent Office to support the restriction, Applicants respectfully request that the restriction of Group II claims from Group I claims, at least with regard to the invention described in claims 23-25 of the Group II claims, be withdrawn, and that at least claims 23-25 of Group II be examined together with the elected Group I claims.

Applicants' second basis for traversing the Election/Restriction Requirement is that it is believed that a search and examination of all claims would place no undue burden on the Examiner (see MPEP §803).

A first and favorable action is respectfully requested. If, for any reason, the Examiner is of the opinion that a telephone conversation with the Applicants' representative would expedite prosecution, the Examiner is kindly invited to contact the undersigned at (617) 573-7851.

Respectfully submitted,



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